Paper No. 22

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

*Ex parte* MARC VAN DEN ZEGEL, JAN CLAES, and JEAN-MARIE DEWANCKELE[1]

Appeal No. 1997-1834
Application No. 08/267,527[2]

HEARD: October 23, 2000

Before JOHN D. SMITH, LIEBERMAN, and TIMM, *Administrative Patent Judges*.

TIMM, *Administrative Patent Judge*.

## *DECISION ON APPEAL*

This is a decision on appeal under 35 U.S.C. § 134 from the Examiner's final rejection of claims 1-8. Claims 9 and 10, the only other claims in the application, stand withdrawn as directed to a non-elected invention.

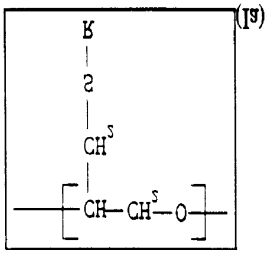
[1]The real party in interest is Agfa-Gevaert.

[2]Application for patent filed June 29, 1994.

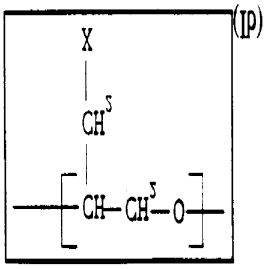
## *BACKGROUND*

Appellants' invention relates to a photographic material. Claim 1 is representative of the subject matter on appeal and is reproduced below:

1. Photographic material comprising a support having on at least one side thereof at least one light-sensitive silver halide layer and at least one non-light-sensitive layer containing in at least one light-sensitive layer spectrally sensitized silver bromide or silver bromoiodide tabular grains having an average thickness of less than 0.30 Fm and which is characterised in that the said photographic material further contains in the said light-sensitive layer(s) and/or in at least one non-light-sensitive layer at least one polyoxyethylene compound comprising from about 20 to 100 mole percent recurring units of the formula (Ia)



and 80 to 0 mole % recurring units of the formula (Ib)



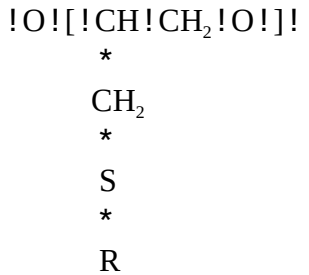
Claims 1-8 stand rejected under the written description requirement of 35 U.S.C. § 112, first paragraph. Claims 1-4 and 6-8 stand rejected under 35 U.S.C. § 103 as being unpatentable over U.S. Patent 5,196,299, issued March 23, 1993 to Dickerson et al. (Dickerson) in view of U.S. Patent 4,013,471, issued March 22, 1977 to Pollet et al. (Pollet).

We reverse the rejection under 35 U.S.C. § 112, first paragraph, for the reasons that follow. We affirm the rejection under 35 U.S.C. § 103 for the reasons cogently articulated by the Examiner. With respect to the obviousness rejection, our comments below are provided primarily for emphasis.

## *OPINION*

### *Written Description*

As originally filed, the Specification included a description of a polyoxyethylene compound "comprising from about 20 to 100 mole percent recurring units of the formula



and 80 to 0 mole % recurring units of the formula

!O![!CH!$CH_2$!O!]!"
*
$CH_2$
*
X

By an amendment filed April 3, 1995, Appellants removed the oxygen atom outside the left bracket of each formula. The Examiner rejects the claims on the basis that the Specification, as originally filed, does not provide support for the formulae as amended.

"The function of the description requirement is to ensure that the inventor had possession, as of the filing date of the application relied on, of the specific subject matter later claimed by him [or her]." *In re Wertheim*, 541 F.2d 257, 262, 191 USPQ 90, 96 (CCPA 1976). The written description requirement serves to guard against an applicant's overreaching by insisting that the applicant recount the invention in such detail that his or her future claims can be determined to be encompassed within the original disclosure. *Vas-Cath, Inc. v. Mahurkar*, 935 F.2d 1555, 1561, 19 USPQ2d 1111, 1115 (Fed. Cir. 1991). If there is an error in the claim and one of ordinary skill in the art would recognize the error and its correction, then it is also apparent that the inventor had possession of the invention and that there is no overreaching. What is key is that persons of ordinary skill in the art be able to recognize from the disclosure that Appellants invented what is now claimed. *In re Wertheim*, *supra*. An obvious

correction of a recognizable error is permissible and will not run afoul of 35 U.S.C. § 112, first paragraph. *In re Oda*, 443 F.2d 1200, 1206, 170 USPQ 268, 272 (CCPA 1971).

Here, we find that one of ordinary skill in the art would have recognized that the inclusion of the oxygen atom outside the bracket of the recurring unit was an error. In fact, the Examiner herself understood the nature of the error before Appellants attempted to correct it. See the paragraph bridging pages 3 and 4 of the First Office Action on the Merits mailed December 1, 1994 (Paper No. 5) in which the Examiner states:

> The recurring units of the formulae (Ia) and (Ib) recited in claim 1 are disclosed on page 3, lines 1-20, of the instant specification. Specific examples of the compounds of the invention comprising said recurring units are disclosed on page 4. In particular, note examples (I.1) and (I.2), comprising recurring units of a polyoxyethylene having a thioether side chain, and the variable "n" indicating the number of recurring units; note that the oxygen atom to the left of the open bracket, "[", is bonded to a hydrogen atom and is not part of the "recurring unit". The specification fails to provide an adequate written description of the polyoxyethylene recurring units by including the oxygen atom to the left of the open bracket, "[", in the formula of the "recurring unit".

Furthermore, as Appellants point out in the Brief at page 5, if the recurring units were drawn out as originally designated, there would be an oxygen to oxygen bond in the resultant compound. Such a compound would not be a polyoxyethylene compound as described in the Specification. Furthermore, compound I.3 exemplified on page 4 of the Specification would not be within the genus of the structural formula. The Examiner's argument with respect to I.3 is duly noted. However, in this case, the fact that I.3 contains an additional error simply indicates that two corrections are required. The presence of

the other error does not negate the obviousness of the error at issue. The Specification as a whole clearly describes I.3 as an example of a compound within the scope of the polyoxyethylene structural formula. One of ordinary skill in the art would have sought to deduce the corrections required to bring the generic formula and examples into conformity. Appellants have convinced us that the error and its correction would be readily ascertainable to one of ordinary skill in the art. Therefore, the claim as amended does not lack support under 35 U.S.C. § 112, first paragraph.

***Obviousness***

In the explanation of the rejection of claims 1-4 and 6-8 for obviousness, the Examiner correctly points out that Dickerson describes a photographic material comprising a support coated with spectrally sensitized tabular grain silver halide emulsion layer units. At least one of the emulsion layer units is comprised of tabular grains having a thickness of less than 0.2 micrometer. In addition, the silver halide grains are preferably silver bromide and can be silver bromoiodide. The Examiner acknowledges that Dickerson does not describe adding a polyoxyethylene compound to one of the layers (Answer, page 4). The Examiner then correctly indicates that Pollet describes the use of polyoxyethylene compounds of the same generic formula as those of the claim for accelerating development or activating development of photographic silver halide elements. The Examiner also explains that the polyoxyethylene compounds encompassed by the claims were well known in the art and that it was common knowledge in the art to incorporate these polyoxyethylene compounds into

spectrally sensitized silver halide emulsions, such as silver bromide or silver iodide, contained in a silver halide photographic material. The Examiner further indicates that the use of the polyoxyethylene compounds to accelerate development of silver halide emulsions was also common knowledge in the prior art. The Examiner logically concludes that it would have been obvious to one of ordinary skill in the art at the time the invention was made to use the polyoxyethylene compounds of Pollet in the photographic material of Dickerson to obtain the advantages described by Pollet in the photographic material of Dickerson (Answer, pages 6 and 8).

In traversing the Examiner's rejection, Appellants argue that there is no reason why one skilled in the art would utilize the compounds of Pollet in the process of Dickerson (Brief, page 8). We note, however, that the Examiner articulated logical reasons why one of ordinary skill in the art would have made the combination. Namely, Pollet specifically describes the polyoxyethylene compounds as accelerating or activating the development of exposed silver halide elements. Therefore, one of ordinary skill in the art of photographic material manufacture would have incorporated the polyoxyethylene compound of Pollet into the photographic material of Dickerson to accelerate and/or activate development.

Appellants list twenty patents which they argue disclose accelerating thioether compounds in silver halide materials. Appellants state that the fact that these twenty patents all disclose thioether accelerators in other silver halide materials emphasizes that there is no reason to utilize the thioether

compounds of Pollet in the silver halide material of Dickerson. The conclusion does not follow the premise. In fact, quite the contrary. It would seem that such wide spread use would be an indication that the thioether accelerators would be useful in a wide range of silver halide materials and that one of ordinary skill in the art would add a thioether accelerator to whatever silver halide material needed accelerating. We note that Dickerson indicates that increased speed and more rapid developability is a desirable advantage in the radiographic element of that patent. See column 1, lines 31-46 of Dickerson.

Appellants observe that Dickerson describes using other compounds to reduce stain and thus the way in which Dickerson describes obtaining low residual stain levels differs from that in the present case (Brief, page 9). Appellants go on to state that it would not be expected that the polyoxyethylene compounds of Pollet would give rise to lower residual staining after processing. The fact that Pollet does not suggest using the polyoxyethylene compound to lower residual staining does not negate the expressly described use as an accelerator and activator. The suggestion, reason or motivation to combine described in the prior art reference need not be the same as that of Appellants to establish obviousness. *In re Kemps*, 97 F.3d 1427, 1430, 40 USPQ2d 1309, 1311 (Fed. Cir. 1996).

To the extent that Appellants are arguing that unexpected results are obtained, we agree with the Examiner that the showing is not commensurate in scope with the claims. See the Answer at page 9.

We conclude that the Examiner has established a *prima facie* case of obviousness with respect to the subject matter of claims 1-4 and 6-8 which has not been sufficiently rebutted by Appellants.

## ***CONCLUSION***

To summarize, the decision of the Examiner to reject claims 1-8 under 35 U.S.C. § 112, first paragraph, is reversed, but the decision of the Examiner to reject claims 1-4 and 6-8 under 35 U.S.C. § 103 is affirmed. Accordingly, we affirm-in-part.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

***AFFIRMED-IN-PART***

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| JOHN D. SMITH<br>Administrative Patent Judge | )<br>)<br>)<br>)<br>)<br>) BOARD OF PATENT<br>) APPEALS<br>) AND<br>) INTERFERENCES<br>)<br>)<br>) |
| PAUL LIEBERMAN<br>Administrative Patent Judge | |
| CATHERINE TIMM<br>Administrative Patent Judge | |

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APPEAL NO. 1997-1834 - JUDGE TIMM
APPLICATION NO. 08/267,527

APJ TIMM

APJ SMITH

APJ LIEBERMAN

DECISION: **AFFIRMED**

Prepared By: Tina

**DRAFT TYPED:** 24 Sep 01

**FINAL TYPED:**